

Attorney's Docket: 1999DE121
Serial No.: 09/578,420
Group: 1714

REMARKS

The Office Action mailed November 14, 2003 has been carefully considered together with each of the references cited therein. The amendments and remarks presented herein are believed to be fully responsive to the Office Action. The amendments made herein are fully supported by the Application as originally filed. No new matter has been added. Accordingly, reconsideration of the present Application in view of the above amendments and following remarks is respectfully requested.

CLAIM STATUS

Claims 1-18 are pending in this Application. By this Amendment, claims 1, 2, 4, 5, and 11-13 have been amended while claims 14-18 have been withdrawn.

Election/Restrictions

The Office has restricted the Application to one of the following inventions under 35 USC § 121:

- I. Claims 1-13, drawn to a process for the production of (metal) salts of an alkylphosphonous acids, classified in class 562, subclass 8; and
- II. Claims 14-18, drawn to the use of a (metal) salt of an alkylphosphonous acid, classified in class 252, subclass 609.

For prosecution in this Application, Applicants elect Group 1, claims 1-13, without traverse.

Priority

The Office notes that Applicants have not filed a certified copy of the German application 199 23 743 upon which priority is claimed. Attached herewith is a copy of the front page of the certified German application 199 23 743.3 and the Transmittal cover letter as filed today by first class, postage prepaid.

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Claim Rejections Under 35 USC § 112, Second Paragraph

The Office states that claims 4 and 5 lack insufficient antecedent basis for the limitation "wherein the organic solvents employed are/is ..." Claims 4 and 5 have been amended, changing their dependency to claim 2 and thereby providing antecedent basis for the above referenced phrase. In consequence, it is believed that the 35 USC § 112, second paragraph rejection has been overcome.

Claim Rejections Under 35 USC § 102

Claims 1-13 stand rejected under 35 USC § 102(e) as being anticipated by Weferling et al., U.S. Patent No. 5,973,194. This rejection is respectfully overcome.

As the Office states, the '194 Patent discloses a process wherein elemental yellow phosphorus is reacted with an alkyl halide in the presence of a hydroxide.

Applicants' invention, as defined by amended claim 1, is directed to a process wherein yellow phosphorus is reacted with an alkyl halide in the presence of a base selected from the group consisting of carbonates, bicarbonates, amides, alkoxides and amine bases. As the '194 Patent does not disclose, teach, or suggest the use of these bases for the reaction, it is respectfully contended that Applicants' invention is not anticipated thereby.

Claim Rejection Under 35 USC § 103

Claims 1-13 stand rejected under 35 USC § 103(a) as being unpatentable over Weferling et al. U.S. Patent No. 6,011,172. This rejection is respectfully overcome.

The '172 Patent, like the '194 Patent discloses a process which employs a hydroxide as a base. As it is beyond contention that a finding of obviousness requires the prior art reference to disclose each and every element of a claimed invention, it is respectfully submitted that Applicants' invention, as defined by independent claim 1, is not made obvious thereby. Simply put, the '172 Patent does not teach, disclose, or suggest the use of the bases which are recited by claim 1. Moreover, as the reference provides no motivation for one with ordinary skill in the

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art to employ such bases, any justification for the use of the claimed bases is predicated, in Applicants' opinion, upon the use of impermissible hindsight gained by a knowledge of Applicants' disclosure. For this reason, it is respectfully contented that Applicants independent claim 1, and all claims depending therefrom, are not made obvious by the '172 Patent.

Claims 1-4 and 6-8, and 10-13 stand rejected under 35 USC § 103(a) as being unpatentable over the article entitled "Superbase-Induced Generation of Phosphide and Phosphinite Ions as applied in Organic Synthesis." This rejection is respectfully overcome.

Again, as with the '194 and '172 patents, the above referenced article discloses the use of an alkali metal hydroxide but does not disclose, teach, or suggest the bases which are recited in Applicants' claimed invention. In consequence, for all the reasons advanced with respect to the § 103 rejection over the '172 Patent, it is Applicants' respectful position that claims 1-4, 6-8 and 10-13 are not made obvious by the above cited article.

Double Patenting

Claims 1-13 stand rejected under the judicially created doctrine of obviousness type double patenting as being unpatentable over claims 1-22 of U.S. Patent No. 5,973,194; claims 1-13 of U.S. Patent No. 6,011,172; claims 1-27 of U.S. Patent No. 6,583,315; claims 1-16 of U.S. No. 6,090,967; claims 1-27 of U.S. Patent No. 6,090,968. It is Applicants' position that the present claims are not obvious in view of the above cited claims of the various patents. All of the above cited references teach only the use of a hydroxide in their process, and do not disclose, teach, or suggest the use of the bases as recited in Applicants independent claim 1.

Therefore, it is Applicants' courteous belief that a terminal disclaimer directed toward these patents is not required.

Claims 1-13 stand rejected under the judicially created doctrine of obviousness type double patenting as being unpatentable over claims 1-41 of U.S.

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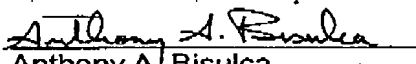
Patent No. 6,359,171 and claims 1-37 of U.S. Patent No. 6,278,012. Attached hereto are terminal disclaimers directed towards the '171 and '012 Patents.

The Office suggests that Applicants submit a new Power of Attorney to make sure all agents who are prosecuting this application are officially made of record. Attached hereto is an associate power of attorney.

As the total number of claims does not exceed the number of claims originally paid for, no fee is believed due. However if an additional fee is required, the Commissioner is hereby authorized to credit any overpayment or charge any fee deficiency to Deposit Account No. 03-2060.

In view of the forgoing amendments and remarks, the present Application is believed to be in condition for allowance, and reconsideration of it is requested. If the Examiner disagrees, he is requested to contact the attorney for Applicants at the telephone number provided below.

Respectfully submitted,


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